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EXAMINER

BROCKETTI, JULIE K

|          |              |
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| ART UNIT | PAPER NUMBER |
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3713

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/698,032

Applicant(s)

KELLEN, WILLIAM G.

Examiner

Julie K. Brockett

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-22 is/are pending in the application.
- 4a) Of the above claim(s) 11-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 18-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/3/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 11-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on May 12, 2005.

Applicant's election with traverse of claims 1-5, 7-10 and 18-22 in the reply filed on May 12, 2005 is acknowledged. The traversal is on the ground(s) that the claims are not properly grouped and request a different grouping including 4 separate groups based on a species restriction. This is not found persuasive because first the Examiner did not make a species restriction it is a subcombination restriction. Inventions I and II as specified by the Examiner are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as playing a bingo game and having memory to store bingo rules and processing to markup and select the bingo cards. Invention II is an electronic game apparatus merely for a game of chance, not necessarily bingo. Invention II recites structural limitations with regard to the apparatus including a release key for removing a memory cartridge and other housing attributes. Invention II can be used to play any game of chance and does not

require the particulars of invention I to be used. Furthermore, invention I does not require the specific housing structure of invention II to be played. See MPEP § 806.05(d).

Applicant further argues that claim 11 should be examined in Group I since there is believed to be no burden that would necessitate separated claim 11 from the elected claims. The Examiner disagrees and notes that claim 11 while an electronic game apparatus just as claim 1, it further defines the removeable memory including a release key, which is directed more towards the housing of the apparatus rather than how the apparatus operates as in Group I. Furthermore Group I requires the search of only bingo games while claim 11 encompasses any game of chance, which is a much larger and diverse search than that required of Group I.

The requirement is still deemed proper and is therefore made FINAL.

### ***Priority***

Applicant is reminded that he is required to update the priority claims in the specification to include the patent numbers or abandonments of any parent application.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to

Art Unit: 3713

exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2 and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 12, 20 and 22 of U.S. Patent No. 6,645,072 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because they disclose identical subject matter such as an electronic game apparatus comprising memory, a user interface, a central processing unit, etc. for use in the game of bingo.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 recites the limitation "said device" in the second line. There is insufficient antecedent basis for this limitation in the claim. The previous recitation is to an "apparatus" not a "device".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 2, 4, 5, 7, 8 and 18-20, 22 are rejected under 35**

**U.S.C. 102(b) as being anticipated by Birenbaum et al., U.S. Patent No.**

**4,768,151.** Birenbaum discloses an electronic game apparatus. A user interface includes a display adapted to display a bingo card and a keypad configured for entry of bingo numbers (See Birenbaum Fig. 1). Birenbaum has a first memory location to permanently storing a plurality of bingo cards in the game apparatus (See Birenbaum Fig. 3, item 52). The processor is under the control of software to select at least one bingo card from said plurality of bingo cards; wherein said processor selects said at least one bingo card according to a selection rule independent of the user, i.e. without user input (See Birenbaum col. 4 lines 45-52) [claims 2, 18, 22]. For example, the processor

selects the bingo card closest to winning in order to display the card. A central processing unit is adapted under the control of software to markup/daub the bingo cards in play during a bingo game according to the bingo rules in response to entry of bingo numbers using a keypad (See Birenbaum col. 3 lines 41-67; col. 4 lines 1-52) [claims 19]. The processor under the control of software selects bingo cards equivalent to a quantity purchased by a user for each round of bingo (See Birenbaum col. 4 lines 45-52) [claims 4, 20]. For example, if a player purchases only 1 bingo card, then this 1 card is obviously selected for display. The apparatus includes a removable memory (See Birenbaum Fig. 1, item 14 which contains item 52) [claim 7]. The removable memory includes game information for playing at least one round of bingo (See Birenbaum col. 3 lines 50-67) [claim 8]. For example, the removable memory item 52 includes the bingo cards, which can be considered "game information".

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 3 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birenbaum et al., U.S. Patent No. 4,768,151.**

Birenbaum teaches that the selection rule is to select the cards closest to winning and lacks in disclosing that the selection rule is to select the bingo cards randomly. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select the cards randomly so that a player can see how far away from a win any of the cards that they are playing are doing at a particular time [claims 3, 21]. By randomly selecting the bingo cards, the player can watch a variety of their cards displayed and look at each card for possible number combinations that are needed for a win, thereby adding to the excitement of the game.

**Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birenbaum et al., U.S. Patent No. 4,768,151 in view of Nakagawa et al., U.S. Patent No. Re. 34,161.** Birenbaum discloses that the removable memory includes game information. However, Birenbaum lacks in specifically disclosing that the removable memory contains rules for at least one round of bingo or a record of how many bingo cards are to be used in at least one round of bingo. Birenbaum does disclose that the rules for at least one round of bingo are stored in the memory on the circuit board of the apparatus (See Birenbaum col. 4 lines 9-12) [claim 9]. Furthermore the game information stored in the memory of the apparatus of Birenbaum includes a record of how many bingo cards are to be used for at least one round of bingo (See Birenbaum col. 3 lines 43-46) [claim 10]. Nakagawa teaches of a removable memory cartridge that stores game information including game rules



(See Nakagawa abstract, Fig. 1A). It therefore would have been obvious to one of ordinary skill in the art at the time the invention was made to include the rules for bingo and a record of the cards used for play in the removable memory of Birenbaum. As seen by Nakagawa it is well known to store the entire game program and game rules on a removable memory including, game cartridges, CDs, floppy discs, etc. By storing this data in the removable memory, more memory on the main circuit board is freed up. Therefore, a player can store more information externally from the apparatus.

#### ***Allowable Subject Matter***

Claim 1 is allowed over the prior art of record.

Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: while Birenbaum teaches of an electronic gaming apparatus for playing bingo with a plurality of bingo cards, it lacks in disclosing that the memory contains an identifier for the number of bingo cards in play. Birenbaum has no discussion of how the number of bingo cards in play is identified.

#### ***Response to Arguments***

Applicant's arguments filed December 22, 2004 have been fully considered but they are not persuasive.

It is noted that the rejections of claims 1 & 5 have been withdrawn as per the Interview Summary. Claim 1 is allowed and claim 5 would be allowed if written in independent form.

Based on Applicant's arguments the Examiner has dropped the intended use rejections but notes that the references listed above do teach all of the limitations mentioned.

Applicant argues that with respect to claim 2, Birenbaum is limited to selecting cards from permanent memory 52 with the help of a user to apparently store them in non-permanent memory and that nowhere does Birenbaum teach or suggest the features of claim 2 such as "selecting at least one card from a plurality of bingo cards in permanent memory independent of the user." Applicant further notes that "selecting a card closest to winning for display" is performed well after the user has selected the card from memory 52. While the Examiner does agree with this last statement, giving the claims their broadest reasonable interpretation, Birenbaum still does read on the claim language. For example, claim 2 recites "a first memory location to permanently store a plurality of bingo cards" (See Birenbaum memory 52), "a processor under the control of software to: select at least one bingo card from said plurality of bingo cards; wherein said processor selects said at least one bingo card according to a selection rule independent of the user" (See Birenbaum

when the processor selects a card closest to winning to display). Nowhere in the claim language does it state that the processor selects the card from the permanent memory therefore the fact that the processor in Birenbaum selects the card after it is copied from the permanent memory to the other memory does not matter.. Therefore, it is reasonable to read the claim as being able to select the card from the non-permanent memory, which Birenbaum does without the help of the user.

Applicant then argues that if ROM 52 corresponds to the memory feature in claim 2 then it cannot be used to reject the memory of claim 7. The Examiner notes that ROM 52 corresponds to the memory of claim 7 and the first memory location of claim 2. There is nothing preventing ROM 52 from covering both limitations.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

With respect to claims 9 and 10 which state that the removable memory includes game information including rules for at least one round of bingo, the

Examiner notes that Birenbaum does teach of a removeable memory ROM 52 which contains bingo cards, i.e. game information. However the memory does not include the rules for the game or how many bingo cards may be used. Therefore, the Examiner has now added the reference Nakagawa which clearly shows a removable memory for a game that contains rules and other game information. The Examiner further notes that it is common knowledge in the art to have removable memory (cartridges, CDs, floppy discs, etc.) that include rules for how to play a game. By being able to remove the memory it is transportable to other systems, which is advantageous to the user.


Applicant's arguments with respect to claims 11-17 have not been considered since the claims are now withdrawn from consideration.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K. Brockett whose telephone number is 571-272-4432. The examiner can normally be reached on M-Th 8:00-5:00.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Julie K Brockett  
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Art Unit 3713